

REMARKS

Claims 1-43 are currently pending in the subject application and are presently under consideration. Claims 12 and 27 have been amended as shown at pages 2 to 7 of the Reply. Applicant's representative thanks the Examiner for the courtesies extended during the telephonic interview regarding the subject application conducted on June 18, 2007, where it was indicated that claim 1 defines over Kudoh, *et al.* (US 5,948,058) as it does not disclose or suggest a plurality of entries ordered according to the sort criterion as recited in claim 1. Additionally, claims 5 and 10 were indicated allowable over the combination of Kudoh, *et al.* and Morikawa (US 5,613,108) as the aspects of these claims are not taught alone or in combination by the references.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-4, 7-8, 11-14, 16-18, 23-29, 31-33, and 39-43 Under 35 U.S.C. §102(b)

Claims 1-4, 7-8, 11-14, 16-18, 23-29, 31-33, and 39-43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kudoh, *et al.* It is respectfully requested that this rejection be withdrawn for at least the following reason. Kudoh, *et al.* fails to disclose or suggest each and every element recited in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Claims 1 and 43

The claimed subject matter generally relates to providing attribute-specific lists corresponding to an object and updating the lists according to an action on the object. The updating can include, for example, re-ordering the list according to previous actions. Additionally, alternatives can be provided for performing the action relative to objects having a controlling attribute. To this end, claim 1 recites *in response to a first object*

*being subjected to an action, the first object having a controlling attribute, **updating a first list of a plurality of controlling attribute-specific lists corresponding to the controlling attribute of the first object according to a sort criterion related to the action, each list of the plurality of controlling attribute-specific lists corresponding to a controlling attribute and having a plurality of entries ordered according to the sort criterion and providing alternatives as to how the action can be performed relative to objects having the controlling attribute, and in response to the plurality of controlling-attribute specific lists being invoked as to a second object, the second object having a controlling attribute, displaying a second list of the plurality of controlling attribute-specific lists corresponding to the controlling attribute of the second object to provide alternatives as to how the action can be performed relative to the second object.*** Claim 43 recites a similar aspect of **ordering** the list. Kudoh, *et al.* fails to disclose or suggest such claimed aspects.

Kudoh, *et al.* relates to a system for cataloging and retrieving email. In particular, the system can show headers and different mail attributes in the form of an at-a-glance guide. (See Abstract). One or more symbols can be linked to the emails to provide classification thereof. However, Kudoh, *et al.* fails to disclose or suggest **updating a first list of a plurality of controlling attribute-specific lists corresponding to the controlling attribute of the first object according to a sort criterion related to the action, providing alternatives as to how the action can be performed relative to objects having the controlling attribute, or displaying a second list of the plurality of controlling attribute-specific lists corresponding to the controlling attribute of the second object to provide alternatives as to how the action can be performed relative to the second object** as recited in the subject claims.

In particular, the Examiner indicated in the telephonic interview for the subject application, referenced above, that the sorting aspect was not disclosed or suggested by Kudoh, *et al.*; furthermore, Kudoh, *et al.* does not disclose or suggest the other highlighted aspects. Conversely, Kudoh, *et al.* does not disclose or suggest providing alternatives as to how the action can be performed. In the section cited by the Examiner, Kudoh, *et al.* discloses classifying emails as sent, received, *etc.*; however, this is not indicative of providing alternatives as recited in claim 1. Rather, Kudoh, *et al.* does not

seem to be providing any alternatives but is merely classifying emails. Additionally, Kudoh, *et al.* cannot, then, be said to described providing alternatives in a second list as recited in claim 1 either.

In view of at least the foregoing, it is readily apparent that Kudoh, *et al.* fails to disclose or suggest each and every element of independent claims 1 and 43. Thus, rejection of these claims, as well as, claims 2-4, 7-8, and 11, which depend therefrom, should be withdrawn.

Claims 12 and 27

Claim 12 as amended (and similarly amended claim 27) recites *updating the at least one attribute-specific list based on an action performed on at least one attribute-specific object, and displaying the updated attribute-specific list upon an action performed on a disparate attribute-specific object*. Thus, the list can be updated according to an action by one object and the updated list displayed according to action by another object. Kudoh, *et al.* fails to disclose or suggest such claimed aspects. Rather Kudoh, *et al.* merely classifies emails and does not recite such inference type behavior as recited in claims 12 and 27 where lists can be updated based on previous actions. Therefore, Kudoh, *et al.* does not disclose or suggest each and every element of claims 12 and 27. Accordingly, rejection of these claims, as well as claims 13-14, 16-18, 23-26, 28-29, 31-33, and 39-42, which depend therefrom, should be withdrawn.

II. Rejection of Claims 5-6, 9-10, 15, 19-22, 30, and 34-38 Under 35 U.S.C.

§103(a)

Claims 5-6, 9-10, 15, 19-22, 30, and 34-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kudoh, *et al.* in view of Morikawa (US 5,613,108). It is requested that this rejection be withdrawn for at least the following reasons. Kudoh, *et al.* and Morikawa, when taken alone or in combination, fail to teach or suggest all elements recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In particular, Morikawa fails to make up for the aforementioned deficiencies with respect to claims 1, 12, and 27, from which claims 5-6, 9-10, 15, 19-22, 30, and 34-38 respectively depend. Therefore, rejection of these claims should be withdrawn. Additionally, the Examiner acknowledged in the telephonic interview that Morikawa also fails to teach or suggest aspects of claims 5 and 10; namely *each of the first object and the second object corresponds to a file* and *the sort criterion is how frequent the action has been performed*. Thus, rejection of these claims should be withdrawn on these additional grounds.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP289USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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